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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,628	10/17/2003	David Scott Jones	47004.000259	8909
21967 7590 10/17/2008 HUNTON & WILLIAMS LLP INTELLECTUAL PROPERTY DEPARTMENT 1900 K STREET, N.W. SUITE 1200 WASHINGTON, DC 20006-1109				
EXAMINER				
LOFTUS, ANNE				
ART UNIT		PAPER NUMBER		
3692				
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10/17/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/686,628

**Applicant(s)**

JONES, DAVID SCOTT

**Examiner**

ANN LOFTUS

**Art Unit**

3692

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 July 2008.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 and 31-34 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-28 and 31-34 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date 10/3/08  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of the Claims***

1. This action is in response to an amendment filed on 7/17/08. Claims 1-28, 31-34 are pending.
2. The application was filed on 10/17/03 without provisional.

### ***Response to Arguments***

3. Applicant's arguments have been fully considered but they are not persuasive.

As to the 35 USC 112 rejection concerning "regular mail," the applicant argues that the US Postal Service is an example of regular mail. This example does not clarify the boundaries of the scope, i.e. how to judge whether a mail service is a regular mail channel or not. In order for the scope to be clear, the distinction between within the scope and without must be clear. Examples often show the center of the scope without defining the boundaries. Is the US Post Office the only regular mail channel? Is any service that delivers mail a regular mail channel?

As to the 35 USC 103 rejections, the applicant argues that Allen does not teach electronically transmitting payment data associated with the payment product to an intended recipient for processing and destroying the payment product at the payment processing system, because although Allen does describe it, Allen does so in the context of a mis-addressed payment, and that Allen does not describe the advantages of such a system. The examiner finds that there is enough support in Allen to suggest

that feature as an alternative, and that it is not required that Allen teach the advantages. A reference can be relied upon for all that it might suggest, and not only the preferred embodiment (Merck & Co. Inc. v Biocraft Laboratories Inc. 10 USPQ 2d, 1843 (CA FC 1989)). Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or non-preferred embodiments (In Re Susi, 169 USPQ 423 (CCPA 1971)).

The applicant argues that as to claim 10, Allen does not teach the intended recipient identifies a payment type based on the payment data. The term payment type can be broadly interpreted to include any type of payment characteristic. Here the examiner has used it to refer to a payment type of accepted payments vs a payment type of returns. Allen teaches the operator on behalf of the intended recipient identifying a payment type and clearing path.

As to the 35 USC 101 rejection, since the specification on page 4 specifically includes carrier signals as a medium, the claim must positively exclude this embodiment. Merely citing a medium does not exclude the carrier since it is in the specification.

4. The applicant's attempt at traversing the Official Notice findings as stated in the previous Office Action is inadequate. Adequate traversal is a two step process. First, the applicant must state the traversal on the record in the next reply. Second and in accordance with 37 C.F.R. §1.111(b) which requires the applicant to specifically point out the supposed errors in the Office Action, the applicant must state *why* each Official

Notice statement is not to be considered common knowledge or well known in the art. Statements generalizing about several Official Notice statements are rarely specific enough to adequately point out errors. In this application, while the applicant has clearly met step (1), the applicant has failed step (2) since there is no argument stating *why* each Official Notice statement is not to be considered common knowledge or well known in the art. Because the applicant's traversal is inadequate, the Official Notice statements are taken to be admitted as prior art. See MPEP §2144.03.

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 31 and 34 are rejected under 35 U.S.C. 101 because the specification on page 4 near line 15 says that a medium can be a carrier wave. Thus the broadest reasonable interpretation of medium in light of the specification includes a carrier wave. Carrier waves are not included in the four statutory categories: process, machine, manufacture, or composition of matter. See *In re Petrus Nuijten* CAFC 2006-1371, which says that something transient or fleeting cannot constitute a manufacture under 35 USC 101 (1356). In particular, a machine readable medium storing instructions falls under functional descriptive material and requires a physical medium for subject matter eligibility. The computer readable medium must be a tangible physical structure, not merely a signal or carrier wave, which permits the functionality to be realized within the computer. A program product without a physical medium has negligible physical form,

and thus is not statutory. A claim that includes within its scope a non-statutory embodiment must be rejected under 35 USC 101.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 13, 27, and 32-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claims 13 and 27, the negative limitation "not sent into a regular mail channel" is unclear. Regular is a relative term, and there is no standard for determining the required degree of regularity. The examiner is unclear as to which mail channels are regular and which are not. Is Fedex regular?

As to claims 32, 33, and 34, the phrase "proximate to the local post office" is a relative term. How close does it have to be to fall within the scope of the claim? The metes and bounds of the claim are unclear, thus the claim is rejected.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1, 3, 5-8, 10-13, 15, 17, 19-22, 24-27, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Application 2003/0200107 filed 8/8/02 by Allen (provisional 3/13/02).\

As to claims 1, 15, and 31, Allen teaches receiving a mail item comprising a payment product at a mail facility and identifying a routing code associated with the mail item and routing the mail item to a payment processing system based at least in part on the routing code (paragraph 41 - 42 page 3). The examiner interprets a mail facility to include a facility that receives mail. Allen teaches at the payment processing system extracting the payment product from the mail item (paragraph 97 page 7)..Allen teaches wherein the payment processing system and the mail facility are local (paragraph 52 page 4 and fig 3, which shows the mail facility receiving and extracting mail collocated with payment processing).

Allen teaches electronically transmitting payment data associated with the payment product to an intended recipient for processing (image forwarded to collection processor) and destroying the payment product at the payment processing system (paragraph 95 page 7) but this is in a slightly different embodiment. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the first embodiment to add electronically transmitting payment data associated with the payment product to an intended recipient for processing and destroying the payment product at the payment processing system in order to avoid the cost and delay of securely moving paper checks.

As to claims 3 and 17, Allen teaches a routing code comprised of a Post Office Box identifier in paragraph 41 page 3.

As to claims 5 and 19, Allen teaches the payment processing system is located at the mail facility (paragraph 52 page 4 and fig 3, which shows the mail facility receiving and extracting mail collocated with payment processing).

As to claims 6, 7, 20 and 21, Allen teaches the payment data comprises a portion of the payment product that is scanned for electronic transmission (image forwarded to collection processor, paragraph 95 page 7).

As to claims 8 and 22, Allen teaches the coupon scanned in claim 16, and displayed with the payment product in Fig 9 and paragraph 124 page 9. A person of ordinary skill in the art at the time of the invention would understand that the coupon and check were transmitted from the payment service center scanner to the collection processor where the images are displayed. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Allen to make explicit a payment product electronically transmitted with items associated with the payment product in order to reduce tracking and shipping paper and also to keep the coupon and check information together for easy reference.

As to claims 10, 11, 24 and 25, Allen teaches a recipient (collection processor) determining a payment type (acceptable vs returns) based on the payment data, and determines an appropriate clearing path, in page 4 paragraph 62. See also paragraph 83 page 6.



As to claims 12 and 26, Allen teaches ACH in paragraph 53 page 4 and truncating checks in paragraph 108 page 8. A person of ordinary skill in the art at the time of the invention would understand truncating to mean replacing the physical check with an image replacement document to send via image exchange channels.

As to claims 13 and 27, Allen teaches an item not sent into regular mail (ACH) in paragraph 53 page 4.

As to claims 32, 33 and 34, Allen Fig 3 shows mail items received at a post office. Allen teaches payment processing is proximate to the local post office in paragraph 81 page 6.

11. Claims 2, 4, 9, 14, 16, 18, 23 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen in view of Official Notice.

As to claims 2 and 16, Allen does not explicitly teach a zip code. Official Notice is taken that it is old and well-known to route mail with a zip code. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Allen to add a routing code comprising a zip code in order to make use of a code that is familiar to participants.

As to claims 4 and 18, Allen does not explicitly teach routing codes comprised of numbers and letters. Official Notice is taken that it is old and well-known to use codes comprised of letters and numbers. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Allen to add a routing code

comprising letters and numbers because it would give a greater number of possible code values for a given length code to use both.

As to claims 14 and 28, Allen teaches checks and money orders and other payment instruments in the abstract, and corporate and consumer checks in paragraph 118 page 9. Allen does not explicitly teach cashier checks. Official notice is taken that these are old and well-known methods of payment. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Allen to add cashier checks in order to be compatible with contemporary payment forms.

As to claims 9 and 23, Allen teaches scanning a payment coupon in claim 16. Allen teaches scanned correspondence pages in Fig 9 and paragraph 124 page 9. Allen teaches electronically transmitting the check as above. Allen refers to information associated with the check, but does not explicitly teach remittance advice, a statement nor accounts receivable data. Official Notice is taken that this is data commonly associated with a payment. It could have been scanned, transmitted and displayed as correspondence. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Allen to explicitly add remittance advice, a statement and accounts receivable data in order to keep associated information with the check data for easy reference.

### ***Conclusion***

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. While portions of interest have been indicated, all references should be considered for the entirety of their teachings.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ann Loftus whose telephone number is 571-272-7342. The examiner can normally be reached on M-F 8-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on 571-272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AL

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